

PATENTDocket No. 2119-4282
Serial No. 10/627,449REMARKS

Claims 1-60 are pending in this application and have been subjected to restriction under 35 U.S.C. §121 because, in the Examiner's opinion, as set forth in the Detailed Action, the application contains claims directed to four patentably distinct inventions as follows:

Group I: claims 1-34, drawn to a method of preparing recombinant nucleic acids, classified in at least, for example, class 435, subclasses 6 and 91.2;

Group II: claims 35-50, drawn to nucleic acids, classified in at least, for example, class 536, subclass 23.6;

Group III, claims 51-54, drawn to methods of conferring herbicide tolerance in a plant, classified in at least, for example, class 800, subclass 278; and

Group IV, claims 55-60, drawn to methods of predicting herbicide efficacy, classified in at least, for example, class 435, subclass 468.

As stated above, applicants provisionally elect Group III, including claims 51-54 for prosecution. Applicants respectfully disagree with the restriction requirement imposed by the Examiner and the characterizations made of the claimed invention. Accordingly, this election is made with traverse.

Although the Examiner also makes a species election requirement, this requirement is limited to groups I and II and does not affect the election of group III. Therefore, applicants response is complete, without a species election.

It is the Examiner's position that restriction is appropriate because the groups contain claims that have different steps and searching would be unduly burdensome. Applicants respectfully disagree with the Examiner's position.

According to M.P.E.P. §803, there are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (1) The inventions must be independent or distinct as claimed; and
- (2) There must be serious burden on the Examiner if restriction is not required.

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Applicants respectfully submit that (1) all groups of restricted claims are properly presented in the same application; (2) undue diverse searching would not be required; and (3) all claims should be examined together.

The Examiner has not shown that examination of all the pending claims would require undue searching and/or place a serious burden on the Examiner, which is a requisite showing for proper issuance of a restriction requirement. In fact, applicants submit that to properly search any one group, other group classifications must be considered as well to perform a comprehensive search.

Two of the four groups of art are classified in class 435. To search prior art in 3 groups cannot be deemed "undue diverse searching." Accordingly, the applicants respectfully traverse the requirement for restriction at least on the grounds that examining the identified groups would not be unduly burdensome.

Applicants respectfully submit that the Requirement for Restriction is improper for at least the reason stated, and request that the Restriction Requirement be withdrawn and all presented claims be examined on the merits.

In view of the foregoing, applicants respectfully submit that claims 1-60 as listed herein are properly presented in this application and that the claims are allowable over the art prior art.

AUTHORIZATION

No fees are believed due in connection with this response and this paper is believed to be timely filed. However, should an extension of time be necessary, such extension is hereby petitioned. The Commissioner is authorized to charge any fees or credit any overpayments which may be required for this paper to Deposit Account Number 13-4500, Order No. 2119-4282.

In the event that a telephone conference would facilitate prosecution, the Examiner is invited to contact the undersigned at the number provided.

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An early and favorable decision on the merits is respectfully requested.

Respectfully submitted,

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